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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,864	12/20/2001	Thomas Ried	14014.0319U2	8947

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06/02/2003

Gwendolyn D Spratt
Needle & Rosenberg
Suite 1200 The Candler Building
127 Peachtree Street NE
Atlanta, GA 30303-1811

EXAMINER

YU, MISOOK

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 06/02/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/937,864

Applicant(s)

RIED ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): none.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1 and 7-20.Claim(s) withdrawn from consideration: 21-25.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Misook Yu 5/29/2003

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that claims 21-25 should be rejoined with the examined claims because the Office has not shown the claims 21-25 were distinct and independent, and also argues that the Office has not shown examination of the claims would put search burden on the examiner. This is not found persuasive. MPEP 802.01 provides that restriction is proper between inventions which are independent or distinct. Here, the invention of the claims 21-25 and the examined invention are distinct for the reasons set forth in Paper No. 10. As to the question of burden of search, the added claims (after the Office action on merits) have different purpose and also have different active steps. Classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not coextensive and is much more important in evaluating the burden of search. Different searches and issues are involved in the examination of each group. Therefore the claims 21-25 remain withdrawn from further consideration.

Applicant argues that WO 97/38313 teaches negative selection of rare cells while the instant invention uses positive selection, but this argument is not persuasive because the argument is not commensurate in scope of the claims and applicant argues with a limitation not present in the claims. The claims do not say the enrichment step involves only positive selection. WO 97/38313 teaches enriching circulating epithelial cells by contacting the samples with an agent that binds with the epithelial cells. Note pages 1, 2, and 20. As for claims 17 and 19, applicant argues that WO 97/38313 does not teach correlating step of cancer progression and effectiveness of cancer therapy but these argument is persuasive because WO 97/38313 teaches method of correlating cancer progression and effectiveness of cancer therapy by determining how much circulating rare epithelial cells are present. Note page 25.

Applicant argues that the limitation "detection of the complex" step in Raclia did not distinguish between cancer and non-cancer but this argument is not persuasive because Raclia teach detection of complex leads to conclude which is cancer is which is not. See especially Fig. 3 at page 4592.


MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1800 1606